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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,118	08/26/2003	Stanley D. Arasmith	043505-262883	5876
826	7590	09/08/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/650,118

Applicant(s)

ARASMITH, STANLEY D.

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 and 68-79 is/are pending in the application.
- 4a) Of the above claim(s) 52-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 11, 13, 14, 19, 20, 22, 23, 26, 29, 31, 35, 37, 38, 41, 44, 46, 48, 49, 68, 69, 71, 74 and 77 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 10, 12, 15-18, 21, 24, 25, 27, 28, 30, 32-34, 36, 39, 40, 42, 43, 45, 47, 50, 51, 70, 72, 73, 75, 76, 78 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the invention of Group I (clms. 1-51, 68-79) in the reply filed on June 22, 2005 is acknowledged. The failure of Application to positively recite any traversal arguments renders the election an election without traverse.

Claims 52-67 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 22, 2005.

### ***Priority***

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application(s), 60/189,317 and 60/202,721 and U.S. Patent No. 6,575,066 upon which priority is claimed do not adequately correlate to the bibliographic data, i.e., the bib data states the currently pending application to claim priority to provisional application 60/406,022, filed 8/26/02. Furthermore, the Oath/Declaration is silent to any priority claimed from any application. Correction is required.

Additionally, provisional applications 60/189,317 and 60/202,721 as well as U.S. Patent No. 6,575,066 fail to provide adequate support under 35 U.S.C. 112 for claims 1-51 and 68-79.

### *Oath/Declaration*

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not properly state any prior application or Patent from which priority is claimed.

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract exceeds 150 words. Correction is required.

The disclosure is objected to because of the following informalities:

- Pg. 15, line 8, "*is not be limited to*" is not clear/grammatically correct

Appropriate correction is required.

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "11" (pg. 28, lines 12, 13) and "112" (pg. 28, line 10) have both been used to

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designate overs. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 8, 11, 22, 26, 29, 37, 41, 44, 48, 49, 71 and 79 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 8, 26, 41 and 71 the terms, "said endless feeder path", "said endless path" and "said feeder path" are used, it is not clear if they all refer to the same path or differing paths. *Examiner suggests use of the same term for consistency and clarity where the same element is referenced.*

There are no antecedent bases for the following:

"said fence" (clm. 11, line 2; clm. 29, line 2; clm. 44, line 2)

"said one or more paddle assemblies" (clm. 22, line 1; clm. 37, line 1; clm. 79, line 1)

“said chute load sensor” (clm. 48, line 1)

“said chute actuator” (clm. 49, line 1)

“said disengage position” (clm. 49, line 1)

With regard to claims 22, 37 and 79, it is not clear how the paddle assemblies relate to the rest of the positively recited elements. A clear understanding of the claimed invention could not be ascertained. Accordingly no prior art has been applied. Clarification as it relates to “*said paddle assemblies*” and “*said dam*” is required to facilitate a clear understanding of the claimed invention and proper application of the prior art. Examiner notes that antecedent basis for “*said paddle assemblies*” is found in claim 5 and antecedent basis for “*said dam*” is found in claim 19.

Claims 48 and 49 appear to be dependent upon claim 47, for the purposes of examination; claims 48 and 49 are understood to depend from claim 47.

Claims 48 and 49 if re-written to depend from claim 47 would contain allowable subject matter.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 13, 68 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Bateman (5,413,286). With regard to claims 1 and 68, Bateman discloses an apparatus for

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reducing the size of wood chips, said apparatus comprising: a sawing assembly (18) having an array of blades (40, 90, 100, 106) disposed upon a shaft (34) and configured to be driven at a cutting speed in a first rotation direction (rotational arrow, fig. 1), said shaft defining a shaft interference zone; a feeder assembly (12,14) configured to direct a flow of said wood chips along a feeder path (col. 5, lines 26-30) passing into and through said array of blades, said feeder assembly defining a feeder zone at least partially intersecting said array of blades; a topper assembly (13) positioned proximate said feeder path, said topper assembly located upstream of said saw assembly (fig. 1) relative to said feed path, said topper assembly (13) configured to reduce the height of said flow of said wood chips such that said flow of wood chips does not tend to extend into said shaft interference zone (col. 5, lines 21-25, 30-37). Examiner notes that Bateman discloses the feed wheel (14) operatively coupled to topper assembly (13) such that the topper assembly levels the feed wheel (14) to inhibit tilting of the feed wheel (14) thus inherently reducing the height of said flow, i.e., a leveled wheel (14) will be lower than a tilted end of the feed wheel (14).

With regard to claims 2 and 69, Bateman discloses the saw assembly (18) positioned such that said shaft interference zone nearly intersects tangentially with said feeder zone (fig. 1).

With regard to claim 3, Bateman discloses said topper assembly (13) positioned such that said topper zone nearly intersects tangentially with said feeder zone (fig. 1, 11).

With regard to claim 13, Bateman discloses a conveyor (12) assembly providing an incoming flow of wood chips.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bateman (5,413,286) in view of Hughes et al. (3,585,761). Bateman discloses a rotary cutter with a plurality of cutting discs/blades (40) mounted upon a shaft/arbor (34) for rotation. Bateman does not disclose spacers. Hughes teaches the use of a rotary cutter (fig. 1) having a plurality of cutting discs/blades (27) mounted upon an arbor/shaft, wherein spacers (26) are disposed intermittently between the cutting discs/blades (fig. 1). Hughes teaches this construction so as to minimize torque on the cutting discs/blades and to maintain the cutting discs/blades upon the shaft/arbor parallel configuration relative to each other. Because the references are from a closely related art and deal with a similar problem, (i.e. rotary members having a plurality of cutting discs mounted upon a shaft); it would have been obvious at the time of the invention to one having ordinary skill in the art to provide Bateman's rotary cutting assembly (18) with spacers between the cutting discs/blades (40) so as to minimize torque and maintain the cutting discs/blades upon the shaft/arbor relative to each other as taught by Hughes.

Claims 14, 19, 20, 23, 31, 35, 38, 46, 74 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bateman (5,413,286) in view of Serban et al. (5,505,393). With regard to claims 14, 19, 20, 23, 35, 38, 74 and 77, as noted above with reference to claim 1, Bateman



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discloses a saw assembly, feeder assembly, and topper assembly. Bateman does not disclose a chute. Serban teaches in a closely related art a chipping device utilizing a feed wheel (8) in conjunction with a chute (9) and conveyor (16) to feed material to be reduced/chipped to a rotary sawing assembly (3). Serban teaches the use of a chute and conveyor so as to feed and guide material to be reduced/chipped, wherein the chute has a floor and lower chute edge (9; fig. 1). Additionally, Serban teaches a dam (15) positioned between said chute (9) and feeder assembly (8, 16), said dam (15) having an inner face oriented toward said feeder assembly (fig. 1, 2), said inner face shaped to nearly coincide with said feeder zone (fig. 1, 2) and a trailing edge and leading dam edge. Serban teaches this construction so as to efficiently feed and guide material to be reduced/chipped to the rotary cutter/sawing assembly. Because the references are from a closely related art and deal with a similar problem (i.e., feeding material to be reduced to a rotary cutter) it would have been obvious at the time of the invention to one having ordinary skill in the art to provide Bateman with a chute so as to efficiently feed and guide material to be reduced/chipped to a rotary sawing assembly (40) as taught by Serban.

With regard to claims 31 and 46, see above with reference to claim 13.

***Allowable Subject Matter***

Claims 5-7, 9, 10, 12, 15-18, 21, 24, 25, 27, 28, 30, 32-34, 36, 39, 40, 42, 43, 45, 47, 50, 51, 70, 72, 73, 75, 76, 78 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 8, 11, 26, 29, 41, 44 and 71 would be allowable if re-written to overcome the 35 U.S.C. 112 rejections due to their dependency upon claims containing allowable subject matter.

The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record does not disclose or fairly suggest an apparatus for reducing the size of wood chips comprising:

- *a feeder assembly comprising paddle assemblies configured to be driven along a feeder path in a direction generally opposing said first rotational direction* in combination with the rest of the claimed limitations as set forth in claims 5, 24, 39 and 70

- *said topper assembly comprises one or more topper blades and configured to be driven at a topping speed in said first rotational direction* in combination with the rest of the claimed limitations as set forth in claims 12, 30, 45 and 73.

- *a chute actuator configured to move said chute relative to said feeder assembly between said engaged position and a disengage position, said disengaged position characterized by said chute guiding said wood chips away from said feeder assembly* in combination with the rest of the claimed limitations as set forth in claims 15, 32, 47 and 75

- *said dam is stationary relative to said feeder assembly* in combination with the rest of the claimed limitations as set forth in claims 21, 36, 50 and 78

As noted above, the prior art reference, Bateman discloses an apparatus for reducing the size of wood chips wherein a feeder assembly comprises a wheel (14), conveyor (12) and hydraulic assembly/topper assembly (13) for feeding material to be further reduced/chipped to a sawing assembly (18) wherein the sawing assembly comprises blades, discs, stationary hammer assemblies and sawing hammers operatively coupled to a main shaft (34) for rotation in the same

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direction as the feeder assembly. Bateman however, is silent to any *chute, dam or topper assembly having blades driven in a first rotational direction* and instead discloses the topper assembly to be movably reciprocally via a hydraulic structure. Further Bateman does not disclose *paddle assemblies rotating in a direction generally opposing said first rotational direction*. Accordingly, Bateman neither anticipates nor renders obvious the claimed invention as set forth in claims 5, 12, 15, 21, 24, 30, 32, 36, 39, 45, 47, 50, 70, 73, 75 and 78.

Further, Serban et al. discloses an apparatus for reducing material wherein a chute (9) works in conjunction with a feeder wheel (8) and conveyor (16) to guide and feed material to be reduced/chipped to a rotary cutting member (3). Serban also teaches a chute assembly (9) having an end and a dam (15) interposed between the chute (9) and the feeder assembly (8, 16) wherein the dam (15) is that pivotally movable about a horizontal axis (20) and spring (21), Serban teaches this construction so as allow large and difficult to reduce material/pieces to be reduced. Such that the large pieces effect the pivotal movement (20) and spring (21) to allow the distance to the rotor (3) to be enlarged and subsequently reduce the size of the large pieces. Serban is silent to any *topper assembly* and movement of the chute from an engaged position to a *disengaged position* and instead teaches only the chute in an engaged position with the conveyor (16) of the feeder assembly (fig. 1, 2). Serban also fails to disclose or fairly suggest a stationary dam and instead teaches the dam (15) to be pivotally movable for chipping larges pieces of material. Accordingly, Serban fails to anticipate or render obvious the claimed invention as set forth in claims 5, 12, 15, 21, 24, 30, 32, 36, 39, 45, 47, 50, 70, 73, 75 and 78.

Neither the prior art of record, nor any combination thereof discloses the claimed invention as set forth in claims 5, 12, 15, 21, 24, 30, 32, 36, 39, 45, 47, 50, 70, 73, 75 and 78.

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Therefore, claims 5, 12, 15, 21, 24, 30, 32, 36, 39, 45, 47, 50, 70, 73, 75 and 78 and their dependents contain allowable subject matter over the prior art of record.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

August 31, 2005